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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/669,959	09/26/2000	Scott C. Harris	TV-Browsing/SCH	5133
23844	7590	08/27/2004	EXAMINER	
SCOTT C HARRIS P O BOX 927649 SAN DIEGO, CA 92192			BUI, KIEU OANH T	
			ART UNIT	PAPER NUMBER
			2611	

DATE MAILED: 08/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/669,959

Applicant(s)

HARRIS, SCOTT C.

Examiner

KIEU-OANH T BUI

Art Unit

2611

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-10, 14-16 and 21 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 11-13 and 17-20 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 2.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: ____.

DETAILED ACTION

Election/Restriction

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-10, 14-16, and 21 drawn to a method and a system for a remote TV system, classified in class 725, subclass 25.
 - II. Claims 11-13 and 17-20, drawn to a system and its method for accessing to the Internet site with identifying the source by its address, classified in class 709, subclass 217.
2. The inventions are distinct, each from the other because of the following reasons:
3. Inventions I, and II are related as combination and subcombinations. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because invention I drawn to a method and a system for a remote TV system. The subcombination has separate utility whereas invention II is about a (distinct) method for accessing to the Internet site with identifying the source by its address. See MPEP § 806.05(d).
4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

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5. Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.

6. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

7. During a telephone conversation with Mr. Scott Harris on 8/19/04 a provisional election was made with traverse to prosecute the invention of 09/669,959, claims 1-10, 14-16, and 21. Affirmation of this election must be made by applicant in replying to this Office action. Claims 11-13, and 17-20 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Rejections - 35 USC 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

9. Claims 1-10, 14-16, and 21 are rejected under 35 U.S.C. 102(e) as being anticipated by Kamada (U.S. Patent No. 6,622,306 B1).

Regarding claim 1, Kamada discloses “a system, comprising: a television remote which has first buttons controlling at least a plurality of functions on a controlled television which is separate from said television remote, said television remote mounted in a housing, which housing is totally separate from the television being controlled by the remote, and said television remote also having a command which accesses information from a hyperlink that is associated with a program that is being currently displayed on the television”, i.e., a user can use a remote controller as illustrated in Figure 2 with a plurality of buttons for different functions, as the user selects the URL 49 button, for accessing the Internet or HTML document using the remote controller for controlling functions on the separate television set, as clearly shown in Figure 9, as the user can access to a hyperlink displaying on the television screen, whereas the remote controller is separated from the television (see col. 1/line 55 to col. 2/line 58 for an overview; col. 4/lines 44-63 for navigator feature; col. 5/line 40 to col. 7/line 4 for details on HTML

documents and hyperlink links; and col. 8/lines 32-44 for URL access; and col. 9/lines 5-45 for hotspots).

As for claim 2, in further view of claim 1, Kamada shows “wherein said remote communicates with a separate computer, to display said information from said hyperlink on the separate computer”, i.e., the remote controller communicates with an Internet unit regarding as a separate computer for displaying the hyperlink on the separate computer using the TV display; furthermore, internet module can be incorporated into the TV system (Figs. 3 & 5 & 9, and col. 3/line 65 to col. 4/line 23 & col. 10/lines 9-20).

As for claim 3, in further view of claim 2, Kamada discloses “wherein said television remote transmits a command that causes said information to be displayed at a next startup of a process on said separate computer”, i.e., as the user sends a command by selecting the URL button, the information is retrieving and displaying to the user (col. 7/line 40 to col. 8/line 44 for selecting menu including accessing to HTML documents using an URL button).

As for claim 4, in further view of claim 2, Kamada further shows “wherein said information is added to a list of internet favorites on said separate computer”, i.e., a transfer list is registered and recorded as hotspots of homepages or internet favorites is stored on the computer for later accessing (col. 2/lines 10-58 & col. 4/lines 44-63 & col. 6/lines 40-64).

As for claim 5, in further view of claim 1, Kamada inherently discloses “wherein said requested information displays said information from said hyperlink in a separate picture on the television being controlled by the remote, so that both a television program picture, and the internet site represented by the hyperlink, are displayed on the same screen when said command is actuated on said remote”, i.e., the Internet circuit and the television circuit is integrated within

one TV system for both displaying Internet related information and television broadcasting (Fig. 9, and col. 10/lines 11-65).

As for claim 6, in view of claim 1, Kamada discloses “wherein said requested information displays said information from said hyperlink on a personal computer”, i.e., the remote controller communicates with an Internet unit regarding as a separate computer for displaying the hyperlink on the separate computer using the TV display; furthermore, internet module can be incorporated into the TV system (Figs. 3 & 5 & 9, and col. 3/line 65 to col. 4/line 23 & col. 10/lines 9-20).

As for claim 7, in view of claim 1, Kamada discloses “wherein said command that accesses information causes an email to be sent to said user” (Fig. 4/item 3 for e-mail service delivered to the user, and col. 8/lines 32-44).

As for claim 8, in view of claim 1, Kamada shows “wherein said hyperlink includes an indication of a referring source” (Fig. 9 for the source is from cnn.com).

As for claim 9, in view of claim 1, Kamada inherently suggests “wherein said command that accesses information comprises making a purchase of an item that is displayed on the television”, i.e., a guide such as for homepage of a hotel or searching for hotels referring to selecting or searching on booking or purchasing hotels for travel (col. 7/line 52 to col. 8/line 11).

As for claim 10, in view of claim 1, Kamada discloses “wherein said remote includes a separate receiver which receives hyperlinks that are associated with a program that is currently being displayed on the television”, i.e. a separate set top box or an external type internet box receives hyperlinks that are associated with a program that is currently displaying on the television (col. 3/line 65–col. 4/line 63).

Regarding claims 14-16, these claims for “a method comprising: producing, on a viewable screen, an entertainment content which includes an address of an internet site as part of its content; detecting an actuation which indicates a request to visit the internet site; and on said viewable screen, displaying both the original content, and contents of the internet site at the same time” and “a method, comprising: using a remote control device for an entertainment media at a first time to control programming content that is being delivered by said entertainment media, said remote mounted in a housing, which housing is totally separate from a housing of the entertainment media being controlled; and using said remote control device at a second time, to indicate that access is desired to information associated with a hyperlink that is associated with a program that is being carried on the entertainment media” are rejected for the reasons given in the scope of system claims 1-10 as already discussed in details above.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Hatakeyama et al (US Patent 6,545,587 B1), Grant et al (US Patent 6,618,039 B1), Allport (US Patent 6,097,441), Henry (US Patent 6,094,156), Van Dryzin (US Patent 6,127,941), and Matthews, III et al. (US Patent 6,025,837) disclose systems related to portable remote controllers for controlling TV functions with hyperlinks.

11. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, D.C. 20231

or faxed to:

(703) 872-9306, (for Technology Center 2600 only)

Hand-delivered responses should be brought to Crystal Park IV, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Krista Kieu-Oanh Bui whose telephone number is (703) 305-0095. The examiner can normally be reached on Monday-Friday from 9:00 AM to 6:30 PM, with alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Grant, can be reached on (703) 305-4755.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to Technology Center 2600 Customer Service Office whose telephone number is (703) 306-0377.

Krista Bui
Art Unit 2611
August 23, 2004



**KRISTA BUI
PATENT EXAMINER**